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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/221,542	12/28/1998	JACQUES JOSEPH LABRIE	ST9-98-004	4441

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EXAMINER

CHEN, TE Y

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 12/21/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/221,542

Applicant(s)  
Labrie et al.

Examiner  
Te Chen

Art Unit  
2171



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 28, 1998
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Claims 1 - 18 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The current title is imprecise.
3. The cross reference related to the application cited in the specification must be updated (i.e. update the relevant status, with PTO serial numbers or patent numbers where appropriate, on page 1, line 11).

### ***Claim Rejections - 35 USC § 112***

4. Claims 3-6 and 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 3 and 15, it is uncertain what does “transformation information” refer to?

As to claims 4 and 16, it is not clear what does “transformation producing function” refer to?

As to claims 5 and 17, it is indistinct what does “lineage information” refer to?

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### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 3 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 15 and 22 of copending Application No. 09/221,042. Although the conflicting claims are not identical, they are not patentably distinct from each other, because both claimed systems comprise substantially the same elements: means / methods / computer program products which synchronize and navigating data stored on a data storage device via a monitoring tool that operates on a selected object from an information tree catalog, to identify/providing changes of metadata / source of that object and update the catalog accordingly.

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7. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Claim Rejections - 35 USC § 102*

8. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Consentino et al. (U. S. Patent No. 6,055,515).

9. As to claim 7, Consentino et al (hereinafter referred as Consentino) disclosed the invention as claimed including:

1) a computer having a memory and a data storage device coupled thereto that stores data;  
[col. 3, lines 24-47];

2) one or more computer programs, performed by the computer, for selecting a target object in an information catalog and providing information about a source from which the target object was derived [Abstract; col. 9, claim 17].

10. As to claim 8, Consentino further disclosed the target object is represented as a node in a tree structure [Fig. 5; col. 7, lines 55-58].

11. As to claim 9, Consentino further disclosed the system providing the node transformation information [col. 5, lines 5-13; col. 7, line 56 - configurable node labels].

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12. As to claim 10, Consentino further disclosed the system having means to identify a transformation producing function [col. 8, claims 2 and 4].

13. As to claims 11, Consentino further disclosed the system having means for providing lineage information [col. 6, lines 44-48; col. 8, claims 2 and 3];

14. As to claim 12, Consentino further disclosed the system having means for maintaining transformation models for use in providing the lineage information [Fig. 5; col. 7, line 11- indicators and floating menus].

15. As to claims 1-6, the steps in the claimed method are deemed to be made inherit by the functions of the apparatus structure in the combination discussed above, hence were rejected for the same reasons.

16. As to claims 13-18, these claims recite the same features as in claims 1-12 with a computer program product form. As the underlying process has been shown to be taught or fairly suggested by the teachings of Consentino, hence they were rejected for the same reasons giving above.

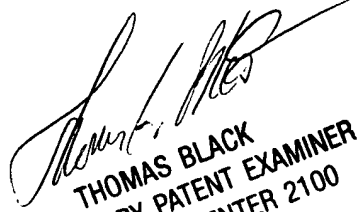
### ***Conclusion***

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17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Schmuck et al. (U.S. Patent No. 6,032,216, 6,023,706, 6,021,508) and Zellweger (U.S. Patent No. 5,630,125).
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Chen whose telephone number is (703) 308-1155. The examiner can normally be reached Monday through Friday from 7:30 A.M. to 4:30 P.M.
19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black, can be reached at (703) 305-9707. The fax phone number for this group is (703)306-5404.
20. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Susan Chen

Dec. 11, 2001

  
THOMAS BLACK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100